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10/585,900	05/22/2007	Dirk Hanisch	Y06Y003PCT-US	4078

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Omori & Yaguchi USA, LLC  
8 Penn Center  
1628 John F. Kennedy Blvd  
Suite 1300  
Philadelphia, PA 19103

EXAMINER
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MERLINO, ALYSON MARIE

ART UNIT	PAPER NUMBER
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3673

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/585,900	<b>Applicant(s)</b> HANISCH, DIRK	
	<b>Examiner</b> ALYSON M. MERLINO	<b>Art Unit</b> 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 13 July 2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the other moving parts must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

3. The disclosure is objected to because of the following informalities: In Paragraphs 8 and 22, reference to the claims should be removed from the specification. Appropriate correction is required.

***Claim Objections***

4. **Claims 1-17 are objected to** because of the following informalities:
- a. In regards to all the claims, it is strongly suggested that the reference characters be removed.
  - b. In regards to claim 13, lines 4 and 5, the phrase "other moved parts" should be "other moving parts."
- Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. **Claims 1-17 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. **Claims 2 and 14-17** provide for the use of the Outsert Method, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

**Claims 2 and 14-17** are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Furthermore, it is unclear which steps are included in the Outsert method, and the examiner would like to point out that the Outsert limitations are process limitations relating to the method or process by which the device is being fabricated. Therefore, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. The Outsert method limitations will be given little or no patentable weight.

9. **Regarding claims 1 and 14-16**, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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10. **In regards to claim 1**, it is unclear how the bearing pin comprises a carrier plate and the locking pieces when it is clear that the motor vehicle door lock includes the carrier plate to form the bearing pin. Furthermore, it is unclear whether the at least one locking piece is a separate component from the locking pieces or is related to those locking pieces. For examination purposes, the claim will be given a broad interpretation until further clarification from applicant.

11. **In regards to claim 6**, it is unclear what is considered as the "main direction of force transfer" from the locking pieces onto the bearing pins since the force and movement relationships between the locking pieces and the bearing pin has not been set forth in the claims. Furthermore, it is unclear whether the bearing pin recited in line 2 is equivalent to the bearing pin recited in claim 1. For examination purposes, the bearing pin recited in claim 6 will be considered equivalent to the bearing pin recited in claim 1 and the claim will be given a broad interpretation until further clarification from applicant.

12. **In regards to claims 8 and 16**, it is unclear what the difference is between the carrier plate and the frame box when it is clear from the specification and the drawings that the carrier plate and the frame box are equivalent. For examination purposes, the carrier plate and the frame box will be considered as equivalent structures until further clarification from applicant.

13. **In regards to claim 9**, it is unclear how the carrier plate is formed by a lock housing when it is clear from the specification and the drawings that the carrier plate and the lock housing are separate components assembled together to house the

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internal components of the motor vehicle door lock. For examination purposes, the claim will be given a broad interpretation until further clarification from applicant.

14. **In regards to claim 11**, it is unclear how two locking pieces can be a catch or a pawl, when it is clear that the locking pieces are a catch and a pawl, and therefore, the "and/or" should be removed. For examination purposes, the claim will be given a broad interpretation until further clarification from applicant.

15. **In regards to claim 12**, it is unclear whether both locking pieces are mounted on the same bearing pin or that each locking piece is mounted on its own separate bearing pin. For examination purposes, the claim will be given a broad interpretation until further clarification from applicant.

16. **In regards to claim 13**, it is unclear to which component the guide grooves to guiding elevations or stops are related. Furthermore, it is unclear how the carrier plate can include the locking pieces as well as enclosing the locking pieces. For examination purposes, the claim will be given a broad interpretation until further clarification from applicant.

17. **In regards to claim 15**, the relationship between the openings or punched-out sections and the clip-shaped form is unclear. For examination purposes, the claim will be given a broad interpretation until further clarification from applicant.

18. **In regards to claim 16**, it is unclear to which component applicant is referring in the limitation "a section of plastic extrusion." For examination purposes, the claim will be given a broad interpretation until further clarification from applicant.

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19. **In regards to claim 17**, it is unclear whether the plastic extrusion coatings are equivalent to the section of plastic extrusion coating, since claim 16 only recites a section and not a plurality of coatings. For examination purposes, the plastic extrusion coatings will be considered as equivalent to the section of plastic extrusion coating of claim 16 until further clarification from applicant.

***Claim Rejections - 35 USC § 102***

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

21. **Claims 1-4, 8-13, and 15-17 are rejected** under 35 U.S.C. 102(b) as being anticipated by Kleefeldt (US-5505506).

22. **In regards to claims 1, 2, and 8**, Kleefeldt discloses a bearing pin 12, 15 for locking pieces 13, 16, in a motor vehicle door lock 1, in which the locking pieces are at least partially rotationally mounted on the bearing pin form a bearing axis (apparent from Figure 1), with the door lock including a carrier plate 2 which is made of a shape-retaining material (Col. 2, lines 48 and 49) and which supports at least one of the locking pieces, and from which a clip shaped form 9 is formed in essentially the axial direction of the bearing axis (apparent from Figure 1) with the bearing pin being formed by means of plastic extrusion coating 12 about the clip-shaped form (apparent from Figure 4).



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23. **In regards to claims 3 and 4**, Kleefeldt discloses that the clip-shaped form is punched out of the carrier plate and moved upright (apparent from Figure 3), and the clip-shaped form is flat (apparent from Figure 3).

24. **In regards to claims 9 and 10**, Kleefeldt discloses that the carrier plate is assembled with a lock housing 8 of the motor vehicle door lock, and an end 12' of the bearing pin is accommodated in a recess (apparent opening surrounding end 12'. Figure 1b) in the lock housing enclosing at least partially the locking pieces (apparent from Figure 2).

25. **In regards to claim 11**, Kleefeldt discloses the locking pieces are a catch 16 and a pawl 13 of the motor vehicle door lock.

26. **In regards to claim 12**, Kleefeldt discloses a motor vehicle door lock 1 with locking pieces 13, 16 mounted on a carrier plate 2, wherein at least one of the locking pieces is mounted on one bearing pin according to claim 1 (apparent from Figure 1 and see rejection of claim 1 above).

27. **In regards to claim 13**, Kleefeldt discloses that the carrier plate and the lock housing enclose the locking pieces and the other moving parts of the motor vehicle door lock (apparent from Figures 1 and 2), produced by an applied plastic extrusion coating (apparent from Figures 1-4).

28. **In regards to claim 15**, Kleefeldt discloses that the edges of openings or punched-out sections forming the clip-shaped form are provided at least partially with a plastic extrusion coating (apparent from Figure 4) covering the edges (Figures 3 and 4).

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29. **In regards to claims 16 and 17**, Kleefeldt discloses that at least partially between the locking pieces and the carrier plate and the lock housing, a section of plastic extrusion coating is applied (apparent that wall portion 6 is formed from plastic, Figure 1 and Col. 2, lines 46-67).

***Claim Rejections - 35 USC § 103***

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. **Claim 5 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Kleefeldt (US-5505506) in view of Kleefeldt (US-5494324). Kleefeldt '506 discloses the bearing pin as applied to claim 1 above, but fails to disclose that the extrusion coating of the clip-shaped form forms a cylindrical bearing pin. Kleefeldt '324 teaches a clip-shaped form 15 having an extrusion coating 3 forming a cylindrical bearing pin (apparent pin portion at reference character 13, Figure 7). Since specifying that the extrusion forms a cylindrical bearing pin would not hinder the ability of the clip-shaped form to be formed in the axial direction of the bearing axis, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify that the extrusion coating form a cylindrical bearing pin since it has been held that a change in shape of a prior art device is a design consideration within the skill of the art.

32. **Claims 6 and 7 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Kleefeldt (US-5505506) in view of Crabb et al. (US-4277964). Kleefeldt discloses the

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bearing pin as applied to claim 1, with the extrusion coating forming the bearing pin (apparent from Figure 4) and the locking pieces having bearing seat openings (apparent openings in lock pieces surrounding the bearing pins, Figure 1) corresponding to the bearing pin, but fails to disclose that the bearing pin has a smaller internal diameter and a larger external diameter and the bearing seat openings having essentially a dovetail-shape corresponding to the bearing pin, with the openings including a smaller internal diameter and a larger external diameter. Crabb et al. teaches a bearing pin (pin at reference character 100, Figure 2) with a smaller internal diameter (diameter of portion 101, Figure 4) and a larger external diameter (external diameter of portion 100, Figure 4), and a locking piece 92 having an essentially dovetail-shaped bearing seat opening 95 corresponding to the bearing pin (Figure 4) with the opening having a smaller internal diameter (diameter of portion 96, Figure 4) and a larger external diameter (diameter of portion 97, Figure 4). Since specifying that the bearing pin has a smaller internal diameter and a larger external diameter, with the bearing seat opening having a corresponding shape would not hinder the ability of the clip-shaped form to be formed in the axial direction of the bearing axis, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify that the bearing pin has a smaller internal diameter and a larger external diameter, with the bearing seat opening having a corresponding shape since it has been held that a change in shape of a prior art device is a design consideration within the skill of the art.

33. **Claim 14 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Kleefeldt (US-5505506) in view of Kluting et al. (US Pub. No. 2003/0020285 A1).

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Kleefeldt discloses the motor vehicle door lock as applied to claim 12 above, but fails to disclose that the locking pieces are partially covered with a plate extrusion coating.

Kluting et al. teaches locking pieces 8, 13 that are partially covered with a plastic extrusion coating 19, 19'. Since specifying that the locking pieces are partially covered with a plastic extrusion coating would not hinder the ability of each of the locking pieces to be mounted on one bearing pin, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify that the locking pieces are covered with a plastic extrusion coating in order to enhance the durability of the locking pieces.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALYSON M. MERLINO whose telephone number is (571)272-2219. The examiner can normally be reached on Monday through Friday, 7:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on (571) 272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter M. Cuomo/  
Supervisory Patent Examiner, Art Unit 3673

AM  
June 4, 2009